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Gregory B. Altshuler

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PALOMAR MEDICAL TECHNOLOGIES

NUTTER, MCCLENNEN & FISH LLP

SEAPORT WEST

155 SEAPORT BOULEVARD

BOSTON, MA 02210

EXAMINER

SHAY, DAVID M

ART UNIT

PAPER NUMBER

3769

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :July 14, 2009; the 6 IDSs of December 31, 2009; and January 6, 2010

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Applicant argues that “all drawings are in conformity with the requirements for drawings as described in 37 C.F.R. 1.84”. The examiner must respectfully disagree. Firstly, it is noted that 37 C.F.R. 1.84 is not the only Rule which sets forth drawing requirements. For example 37 C.F.R. 1.83(a) specifically states that “The drawing in a non-provisional application must show every feature of the claimed invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (*e.g.*, a labeled rectangular box)...”. Clearly the requirement for a symbol or labeled graphical representation is a requirement for an illustration which is readily comprehensible to an observer as to what it represents. This is reiterated and clarified in 37 C.F.R. 1.84(n), which is reproduced below for applicant’s convenience:

- (n) *Symbols* . Graphical drawing symbols may be used for conventional elements when appropriate. The elements for which such symbols and labeled representations are used must be adequately identified in the specification. Known devices should be illustrated by symbols which have a universally recognized conventional meaning and are generally accepted in the art. Other symbols which are not universally recognized may be used, subject to approval by the Office, if they are not likely to be confused with existing conventional symbols, and if they are readily identifiable.

Kindly note that symbols and labeled representations are set forth as alternatives in 37 C.F.R. 1.83(a) and therefore are equivalent. Further, kindly note that the requirement for the use of symbols and labeled representations is set out separate and apart from the requirement for reference numerals. Also kindly note that known devices “should be illustrated by symbols

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which have a universally recognized conventional meaning...". Since applicant has chosen to employ unlabeled representations, rather than the labeled representations clearly called for in 37 C.F.R. 183(a) and 1.84(n), the drawing objections have been maintained and applicant's arguments are not convincing.

Applicant's cooperation in submitting drawings to obviate the examiner's objection are appreciated. These drawings are acceptable.

Regarding the objection to the specification and the attendant rejection under 35 U.S.C. 112, first paragraph, the examiner notes that the previously claimed wavelength range was indeed supported by the originally filed disclosure. However, the examiner cannot agree with applicant's conclusion that the claimed energy densities are so supported. The recitation pointed to by applicant appears to be the sole recitation concerning fluence. Further, in contradistinction to *Wertheim*, as discussed in MPEP 2163.05(III), the currently claimed range, although within the generic range disclosed, is completely outside of the preferred range recited in the originally filed disclosure, and cannot be considered to be particularly disclosed, as was the range in *Wertheim*, that completely encompassed exemplary ranges also disclosed. Thus this argument is not convincing and the objection and rejection based on this recitation has been maintained.

With regard to the art rejections, applicant argues that neither McDaniel nor Altshuler et al does not disclose a method for preventing, reducing, or treating pseudofolliculitis barbae (PFB) in a skin treatment area. The examiner must respectfully note, firstly, that not all claims indicate the treatment of pseudofolliculitis barbe, and that since that as McDaniel and Altshuler et al teach the precise treatment parameters disclosed and claimed, such application to the skin

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will provide the claimed treatment to any hairs present, regardless of the knowledge or intent of Altshuler et al. Thus this argument is not convincing.

The amendment filed October 15, 2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: “the range of about 1350 nm to about 2700 nm”.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 10, 12-14, 16, 17, 20, 24-37, 60-64, 68, 71, 72, and 77 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

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application was filed, had possession of the claimed invention. The originally filed disclosure is silent on “fluence in a range of about 0.01 J/cm² to about 0.5 J/cm²”.

Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 is indefinite as it depends from cancelled claim 19. For the purposes of examination, claim 20 will be treated as depending from claim 10, since the limitation of cancelled claim 19 has been incorporated into claim 10.

Claims 10, 12-14, 16, 17, 24-31, 33, 34, 36, 38-41, 42-44, 46-54, 56-64, 68, 71, 72, and 74-79 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Tankovich et al ('211).

Tankovich et al ('211) employ applicant's disclosed parameters (see column 10, lines 1-19; column 12, line 11 to column 16, line 42; and column 20, line 13 to column 22, line 29) and thus inherently will produce the variously claimed results. If the method of Tankovich et al ('211) does not produce these results, either applicant's claims are incomplete, or the disclosure is fatally defective.

Claims 10, 12-14, 16, 17, 24-28, 60-64, and 74-79 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by McDaniel ('283).

The wavelengths disclosed by McDaniel ('283) are in a ranges of about 360 nm to about 600 nm. Also taught are the pulse widths and fluences claimed (see Example 19, wherein the treated tissue is considered “skin” within the broadest reasonable interpretation of the term) as well as altering parameters and the treatment of various conditions (see paragraphs [0065], [0069], [0074], and [0082]-[0087]). McDaniel ('283) employs applicant's disclosed parameters

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and thus inherently will produce the variously claimed results, or the claims are incomplete, or the disclosure is fatally defective. Further, the proper combination of parameters necessary to provide the various effects must be within the scope of one of ordinary skill in the art, since even applicants narrowest claims would require the determination of the proper combination of parameters from among trillions of possibilities.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10, 12-14, 16, 17, 20, 24-41, 42-44, 46-54, 56-64, 68, 71, 72, and 74-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Altshuler et al in combination with McDaniel ('283) or Tankovich et al ('211). Altshuler et al teach a device and method as claimed except for the particular pulse widths, fluences and wavelengths a billionth of a nanometer different from the claimed ranges. Both McDaniel ('283) and Tankovich et al ('211) teach treating hair using pulse widths and fluences within the claimed range. It would have been obvious to the artisan or ordinary skill to employ the pulse widths and fluences of McDaniel ('283) or Tankovich et al ('211) in the device and method of Altshuler et al, since Altshuler et al make it clear that a vast array of combinations of parameters can be used as long as they are related in the ways defined therein, or alternatively, to employ the parameter interrelations taught by Altshuler et al in the device and method of McDaniel ('283) or Tankovich et al ('211), since the parameter interrelations of Altshuler et al are useful for providing hair treatment, and in either case to decrease the lowest wavelength by 1 nanometer (a decrease of 0.16%) or increase

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the highest wavelength by 1 nanometer (a 0.085% increase), the proper combination of parameters necessary to provide the various effects must be within the scope of one of ordinary skill in the art, since even applicants narrowest claims would require the determination of the proper combination of parameters from among trillions of possibilities, and in either case, to employ shaving clipping application of a depilatory cream or the use of electromagnetic radiation, since this is not critical; is well within the skill of one having ordinary skill in the art; provides no unexpected result; and these are known methods for removing hair, and one of ordinary skill in the art would appreciate their equivalence to the waxing used by McDaniel ('283) or Tankovich et al ('211); to lift the hairs prior to treatment, since this is not critical; is well within the scope of one having ordinary skill in the art; provides no unexpected result; and will prevent the hairs from transmitting heat to the skin by conduction; and to perform the method on hairs that extend from 0.2mm below to 1.0 cm above the skin surface, since this is not critical; is well within the scope of one having ordinary skill in the art; and provides no unexpected result, thus producing a device and method such as claimed.

Applicant's arguments with respect to claims 10, 12-14, 16, 17, 20, 24-41, 42-44, 46-54, 56-64, 68, 71, 72, and 74-79 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Tuesday through Friday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Johnson, can be reached on Monday through Friday from 7:00 a.m. to 3:30 p.m. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/david shay/

Primary Examiner, Art Unit 3769